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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,739	11/24/2003	Andrew C. Harvey	05918-071004 / 3782 (DIV2)	2746
26161	7590	07/21/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EASHOO, MARK	
			ART UNIT	PAPER NUMBER
			1732	
DATE MAILED: 07/21/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,739

Applicant(s)

HARVEY ET AL.

Examiner

Mark Eashoo, Ph.D.

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60-75 is/are pending in the application.
- 4a) Of the above claim(s) 68-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Newly submitted claims 68-75 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 60-67, drawn to an abrasive sheet product, classified in class 428, subclass 100.
- II. Claims 68-75, drawn to a method of making a fastener product, classified in class 264, subclass 167.

The inventions are distinct, each from the other because of the following reasons:

Inventions of group II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as one that is formed by injection molding and laminating techniques. Furthermore, process as claimed can make another product, namely, one that does contain abrasive particles.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 68-75 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 65-67 refer to "the method of claim 60" in the preamble of each claim. As such, the claims are indefinite because it cannot be clearly ascertained if the claims are intended to be product claims (as claim 60) or process claims.

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For the purpose of further examination, claims 65-67 are considered to be product claims thereby further limiting claim 60.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 60, 61, and 64-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Chesley et al. (US Pat. 5,505,747) when taken with Ott (US Pat. 4,609,581).

Chesley et al. teaches the claimed abrasive sheet product, comprising: a sheet-form base having an integral array of fastener elements (figs. 1 and 5); and a substrate having abrasive on the surface thereof, wherein the substrate is laminated to the sheet-form base (4:1-35 and figs. 1, 5). It is inherent that the abrasive particles of Chesley et al. extend, at least partially, from the surface of the product in order for the product to function as an "abrasive article" for the removal of material from a workpiece (1:10-20). This is further evidenced by figure 2 of Ott which shows the type of abrasive articles to which Chesley et al. discloses. (Note: Ott is cited and clearly referred to by Chesley et al. at 1:49-60.)

With respect to claim 61, Chesley et al. also teaches a paper substrate (4:10-15).

With respect to claims 64-67, the only apparent structure that is added to the product by the instantly claimed process limitation is that of hook shape stems (from hook shaped mold cavities, claim 65) and stem heights (from the mold cavity depths, claim 67). As such, Chesley et al. also teaches hook shaped fastener elements and stem heights/lengths of 0.0004 inch to 0.40 inch (5:13-6:60).

Claims 60, 61, and 64-67 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, but only to the structure implied by the steps. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chesley et al. (US Pat. 5,505,747) when taken with Ott (US Pat. 4,609,581).

Chesley et al. teaches the claimed abrasive sheet product, comprising: a sheet-form base having an integral array of fastener elements (figs. 1 and 5); and a substrate having abrasive on the surface thereof, wherein the substrate is laminated to the sheet-form base (4:1-35 and figs. 1, 5). It is inherent that the abrasive particles of Chesley et al. extend, at least partially, from the surface of the product in order for the product to function as an "abrasive article" for the removal of material from a workpiece (1:10-20). This is further evidenced by figure 2 of Ott which shows the type of abrasive articles to which Chesley et al. discloses. (Note: Ott is cited and clearly referred to by Chesley et al. at 1:49-60.)

Chesley et al. also teaches various abrasives such as garnet, emery, silicon carbide, etc. (4:23-35) and particle sizes of P-180 (eg. grade/grit 180). However, Chesley et al. does not specifically teach sand particles in the range grade 30 to 600 (ie. grit 30 to 1200). Nonetheless, Official Notice is given that sand particles or silica particles are a well known abrasive in the range of grade 30 to 600. At the time of invention a person of ordinary skill in the art would have found it obvious to have used sand particles or silica particles in the range of grade 30 to 600, as commonly practiced in the art, in the product of Chesley et al., and would have been motivated to do to provide an alternative and relatively inexpensive abrasive for economic benefit (ie. sale of a lower cost product).

Claims 62-63 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, but only to the structure implied by the steps. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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*Response to Arguments*

Applicant's arguments filed 01-MAY-2006 have been fully considered but they are not persuasive, and have been substantially responded to in the rejection, made final, above.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mark Eashoo, Ph.D.  
Primary Examiner  
Art Unit 1732

me  
July 18, 2006

18/Jul/06